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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,243	01/05/2001	Rudolfus A.T.M. Van Benthem	P 275922 9637US/CONT	3640

909 7590 03/14/2003  
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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/754,243

Applicant(s)

VAN BENTHEM ET AL.

Examiner

Susan W Berman

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 112, 2<sup>nd</sup> paragraph on page 2 of paper no. 15.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached page(s).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 22,23.Claim(s) rejected: 2,3,9-21 and 24-27.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Susan W Berman  
Primary Examiner  
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**DETAILED ACTION**

Applicant's arguments filed 03-06-2003 have been considered but have been found unpersuasive for the following reasons.

Applicant argues that the reaction product of the amide group in formula (I) in claim 2 with a polymer could not result in a urethane linkage since that would eliminate the alkyl amide group. This argument is not persuasive because a reaction between a polymer having hydroxyl groups, such as the cellulose polymer disclosed by Nason et al, with an isocyanatoalkyleneacrylate compound, as disclosed by Nason et al results in a compound of formula  $P\text{-OCNH-R-OCO-C=CH}_2$ , wherein "P" is the residue of the cellulose polymer after reaction of -OH groups with the isocyanatoalkyleneacrylate compound. The linkage to the cellulose backbone will be a urethane link -OOCNH- and this link is encompassed by the instantly claimed formula wherein "P" represents a "polymer" and does not require any particular linking group from the polymer backbone to the radiation curable amidoalkylene(meth)acrylate group. Applicant argues that when "X" in the amide group set forth on page 5 of paper number 16 represents an "organic group" it will bond to a neighboring carbon via another carbon and not via an oxygen atom. This argument is not persuasive because the phrase "organic group" does not exclude groups containing oxygen. Furthermore, nothing in the claim language limits the bond to a carbon-carbon linking bond. The phrase "alkylamide" defines the starting reactant used to provide the radiation curable ethylenically unsaturated carboxylic ester, not necessarily the product of the reaction of that compound with any known polymer having any known reactive groups.

It is suggested that applicant amend the claims to define the polymer and functional group as shown on page 5, lines 1-15, to specify the linking group and file a "Request for Continued Examination" since this limitation would be considered to be a new issue requiring further search and consideration.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman  
Primary Examiner  
Art Unit 1711

SB  
March 12, 2003